

REMARKS

An amendment to Claim 18 has been proposed to correct the obvious clerical error introduced in Claim 18 in the last amendment. That is, in claim 18, the preamble has been amended to refer to a "method" rather than "an apparatus".

Entry of this amendment is urged, since it clearly places the application in better form for Appeal.

Attached hereto is a marked-up version of the changes made to the Claims, headed **"Version With Markings to Show Changes Made"**.

Regarding the merits of the action, first and foremost, it is submitted that a Final Action is clearly improper under the circumstances.

From the outset, the Examiner has failed to examine the apparatus claims of the application (claims 1-5 and 7-9) in accordance with 35 U.S.C. 112, sixth paragraph. This in spite of our directing this to the attention of the Examiner in the last Response filed 22 August 2002. Clearly, this satisfies any onus on the Applicant to do so.

Attention is also directed to the direction given to Examiners in the MPEP at page 2100-211, column 2, last paragraph. That is, "Each claim must be independently reviewed to determine the applicability of 35 U.S.C. 112, sixth paragraph."

It is further submitted that without a proper construction of the apparatus Claims in the manner provided by 35 U.S.C. 112, sixth paragraph, the relevance of the prior art has not been properly assessed.

Accordingly, it is requested that the "finality" of the action be withdrawn, and a new non-Final action be written should any outstanding issues remain.

Nevertheless, in an effort to advance the prosecution of the application, Applicant offers the following analysis and comments.

Claim 1 includes a combination of three means, plus function elements, which together define a new and unobvious apparatus.

Section 2181 of the MPEP provides the Examiner's guidelines for Examination under 35 U.S.C. 112, sixth paragraph.

Such guidelines include a specified three-prong analysis of each claim limitation/element.

It is submitted that all three of these criteria are met by Claims 1-5 and 7-9.

The Search and prior art citation criteria are provided in MPEP sections 2182 and 2183.

Using the guidance of *In re Donaldson*, the Examiner carries the initial burden of proof for showing (for each means plus function element in the claimed combination) that the prior art structure is the same or equivalent thereto.

Looking at the action,, In paragraph 3., Claims 1-5 and 7-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Pawliszyn in view of Murphy.

In paragraphs 4. to 7., Claims 1-3, 5, 10 and 14-19 were rejected under 35 U.S.C 103(a) as being unpatentable over Murphy.

However, no 35 U.S.C. 112, sixth paragraph analysis was performed by the Examiner on Claims 1-5 and 7-9 in relation to Pawliszyn or Murphy.

It is respectfully submitted that a proper 35 U.S.C. 112, sixth paragraph analysis would conclude that the prior art of record, neither anticipates, nor renders Obvious, any of the Claims of record in the application.

Looking first at Murphy, and the rejection of Claims 1-3, 5, 10 and 14-19, under 35 U.S.C. 103(a) based thereon, regarding the "gas tight enclosure means for receiving the sample", the Examiner admits that this essential element of our Claim 1 is missing.

The Examiner also admits that a second essential element of our claimed invention is missing in Murphy, ie. the "means for chemically desorbing the target analytes by solvent extraction by a micro-volume of solvent".

Accordingly, there can be no prima facie case of Obviousness of any of Claims 1-5 and 7-9 established on the basis of Murphy.

It is also emphasized that Murphy relates to non-analogous prior art. By the Examiner's own admission, there is no disclosure in Murphy of the use of a micro-volume of solvent, which is the basis for any "microextraction" invention.

Regarding the Examiner's rebuttal to our prior arguments versus Murphy, the Examiner first states that the "gas tight enclosure means is nothing more than a traditional sample vile with a septum-containing lid". With all due respect, even if the Specification provides such an example of the means in question, Section 112, sixth paragraph requires that the means

element be interpreted to cover the corresponding structure, materials or acts in the specification and equivalents thereof.

Accordingly, the Examiner's statement is meaningless in such a consideration.

The Examiner's typical gratuitous hindsight arguments regarding the seal are also irrelevant to this consideration.

Regarding the issue of headspace sampling, it is apparent that in the absence of a gas tight enclosure means for receiving the sample..., which in effect provides a headspace area in which equilibrium can be achieved between the liquid sample and the headspace, Murphy is restricted to liquid sampling. Our Claim 1 provides for both direct sampling of a sample, and headspace sampling.

Further, with respect to the "support" in the form of a "fiber" of Claim 4, the Examiner alleges that there is no Claim directed to "multiple fibers". The Examiner will appreciate that it is well established in Claim construction that the singular includes the plural. Accordingly, Claim 4 covers both a single fiber embodiment and a multiple fiber embodiment.

Yet further, the Examiner argues that the Claim 5 "means for shielding the cylindrical support from the atmosphere", is shown in Murphy by the needle surrounding the adsorbent". However while there may be some shielding of the adsorbent in this manner, because the needle is open ended, once the needle is evacuated of sample, there is no shielding of the adsorbent from the atmosphere. Clearly, shielding of the adsorbent from the atmosphere is achieved by our defined means. For example, such shielding is achieved when the fiber 1A is positioned within the tubing 3 for transport. See figure 3 for illustration.

Accordingly, it is submitted that this 103(a) rejection should be withdrawn.

Turning now to the rejection of Claims 1-5 and 7-19 as being unpatentable over Pawliszyn in view of Murphy, the Examiner's analysis of the reference in paragraph 3., concludes that "Pawliszyn fails to teach chemical desorption or desorption into a microvolume" of solvent.

If the disclosure of Murphy is combined with this, since Murphy fails to disclose the "gas tight enclosure means" element, it does not satisfy this deficiency of Pawliszyn.

Accordingly, on this basis alone, there is no prima facie case of Obviousness of any of these claims, based upon the combination.

Moreover, neither of Pawliszyn nor Murphy disclose the "means for chemically desorbing the target analytes by a micro-volume of solvent", which is essential to our invention.

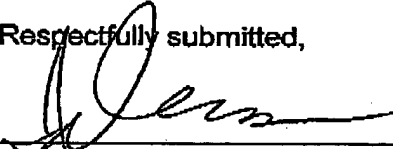
The Examiner argues that the instant Claims do not preclude heating during desorption. However, the means element in question states nothing more than "chemically desorbing..". It is submitted that if this means element is properly construed in accordance with the requirements of 35 U.S.C. 112, sixth paragraph, even with reference to our Specification for specifics thereof and equivalents therefor, the construction does not extend to other non-chemical means, such as heating.

With respect to the "method" claims 10-19, the Examiner argues that the instant method claims do not recite headspace sampling. However, it is submitted that this is not the case. Claim 10 in step (a) covers exposing a "fluid..." sample...to a solid support...".

Clearly, the fluid sample could be in the form of a gas, which could only be sampled in same headspace. At the very least, Claim 12, which specifies that step (a) is effected within a gas tight enclosure, specifically covers this situation.

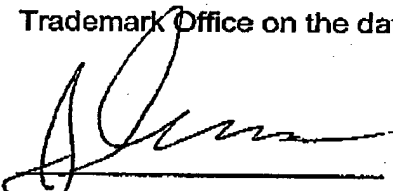
Respectfully submitted,

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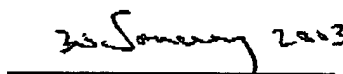

J. Wayne Anderson
Patent Agent for Applicant
Regn No: 28,158
National Research Council Canada
Tel: (613) 993-3899

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J. Wayne Anderson



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Version with markings to show changes made

9. An apparatus according to Claim 4, wherein the fibre is of fused silica, and the coating is of silicone.
10. (amended) A method for solid phase micro extraction of analytes included in
5 a fluid or a solid sample, comprising
(a) exposing a fluid or a solid sample including target analytes, to a solid support which may be coated or uncoated, the support and/or the coating being selected based upon selectivity of the support and/or coating for at least one of the analytes in the sample, for a sufficient time to permit chemical extraction of the analytes by the
10 support to occur, and
(b) ending said contact and then placing said solid support into a micro volume of solvent where chemical desorption of the analytes from the support occurs.
11. A method according to Claim 10, wherein the support is in the form of a fibre.
15
12. A method according to Claim 11, wherein the method is effected within a gas tight enclosure.
13. A method according to Claim 12, wherein the solvent is a suitable organic
20 solvent.
14. A method according to Claim 10, wherein the chemical extraction is by absorption or adsorption of the target analyte by the solid support or coating.
- 25 15. A method according to Claim 10, wherein the sample is in an aqueous solution.
16. A method according to Claim 10 wherein the support is uncoated.
17. A method according to Claim 16, wherein the support is of fused silica.
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18. (twice amended) [An apparatus] A method according to Claim 10, wherein the coating is an organic material selected from the group consisting of

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(b) ending said contact and then placing said solid support into a micro volume of solvent where chemical desorption of the analytes from the support occurs.
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16. A method according to Claim 10 wherein the support is uncoated.
17. A method according to Claim 16, wherein the support is of fused silica.
30
18. (twice amended) A method according to Claim 10, wherein the coating is an organic material selected from the group consisting of polyethyleneglycol and